

Application No. 10/099,827

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REMARKS

Claims 1-20 remain in this application. Claims 12-15, 17 and 18 have been amended. Claims 1, 12 and 17 are independent claims.

A. Claim Rejections – 35 U.S.C. 112

In the Office action dated September 14, 2005, claims 7, 12 and 17 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In response, Applicants have amended independent claims 12 and 17. Applicants submit that the inclusion of claim 7 is a typographical error. The Office action cites three reasons for determining that the pending claims do not satisfy the requirements of Section 112, but none of the reasons applies to claim 7.

It is stated in the Office action that claims 7 and 17 are indefinite because it is unclear as to what is meant by "said file access counter being configured such that counting is collective with respect to said transfers of said network files to said pluralities of clients." It is respectfully pointed out that this language is not found in claim 7. However, the language is found in claim 12. Therefore, Applicants submit that the intent was to reject claims 12 and 17, rather than claims 7 and 17. In response to the rejection, independent claims 12 and 17 have been amended to state that the counting updates a tally of the accesses. Thus, the claims no longer state that the counting is "collective." The amendments to claims 12 and 17 place them in a condition consistent with the description of updating a tally as found in original claim 8. Since claim 8 was considered sufficiently definite under Section 112, Applicants are confident that the amended claims 12 and 17 satisfy the requirements of Section 112, second paragraph.

Claim 12 was also rejected as being unclear because of reference to "clients." Specifically, it was considered that it was unclear as to whether the clients were client computers or clients as human beings or users. The rejection stated that the Examiner interpreted the term as client machines connected to a network. Applicants agree that this is the correct interpretation. Claims 12-15, 17 and 18 have been amended to refer to "client devices," rather than merely "clients." Thus, any indefiniteness regarding the proper interpretation of claim 12 has been removed.

Finally, it was noted in the Office action that while claims 1 and 17 disclose a network file with "instructions," claim 12 discloses a cacheable

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document with a "count-inducing message." Claim 12 has been amended to state that the executable code within a cacheable document includes an instruction. It is the instruction which triggers transmissions of count-inducing messages. Since claim 12 now is consistent with claims 1 and 17 regarding "instructions," there is the required consistency in the description of the invention.

Applicants submit that the amendments to the claims place all of the pending claims in a condition in which the requirements of Section 112, second paragraph are satisfied. Reconsideration of the claims in view of the amendments is requested.

B. Claim Rejections – 35 U.S.C. 103

Claims 1-20 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Evans et al. (2003/0033283) in view of McBrearty et al. (2003/0009496). Applicants respectfully assert that the teachings of Evans et al. have not been correctly interpreted. When properly interpreted, it is clear that the combination of the two patent references does not present a *prima facie* case of obviousness with regard to the pending claims.

Applicants' claimed invention relates to tracking hits/accesses of network files. As noted on page 1 of the pending application, the use of proxy servers has benefits, but a concern is that the use of a proxy server may cause inaccurate counting of the number of hits for a requested file, since at least some of the requests may be intercepted and serviced by the proxy server. As described in claim 1, in sending the network file to a device requesting the file, the file includes an instruction to transmit an indicator subsequent to the receiving of the file by the requesting device. The requesting device transmits the indicator in response to receiving the network file. Then, the method includes processing the indicator to track the hits for the network file.

In comparison, the invention of Evans et al. is directed to a different concern with the use of caching files at a proxy server. The concern to Evans et al. is that files may be updated, so that a cached file ("data set") at a proxy server may not be up-to-date. As noted in paragraph [0004] of Evans et al., a proxy server must ensure that any cached data sets remain up-to-date with respect to changes to the "original" data set held at the originating data source. The concern addressed by Evans et al. is fundamentally different than the concern addressed by Applicants' claimed invention.

Similarly, the solution provided by Evans et al. is fundamentally different than the solution provided by Applicants' claimed invention.

Relating Applicants' claimed invention to magazines available at a community library, Applicants' invention would allow a publisher of a magazine to have an accurate count of the number of readers of the magazine, not just the number of magazines sold. If the magazine were to automatically trigger a sending of an "indicator" to the publisher each time the magazine were read, the number of "hits" could be accurately tracked. In comparison, Evans et al. is concerned with ensuring that the magazine at the library is the most recent publication of the magazine. Once the community library decides to provide a copy of the magazine for access by the public, the library subscribes to the magazine. The transmission of the subscription message to the publisher ensures that the library will be sent a copy of each update. If the library determines that it no longer wishes the update, it transmits an "unsubscribe" message. As will be described more fully below, Evans et al. does not teach or suggest sending the file (data set) so as to include an instruction to transmit an indicator subsequent to the requesting device receiving the file, so that the indicator is processed to track hits for the file. McBrearty et al. was cited only for its teachings regarding tracking numbers of hits. Neither Evans et al. nor McBrearty et al. teaches or suggests the use of a network file that includes an instruction to transmit an indicator as set forth in claim 1.

1. Patentability of Claims 1-11

Claim 1 describes a method of tracking hits that includes a step of receiving a request for a network file from a requesting device. The Office action cites paragraph [0019] of Evans et al. as teaching this step. Applicants agree that this paragraph teaches that a user access request monitor (120) of a proxy server intercepts and monitors messages sent by client devices (200) containing requests for access to data sets stored on data servers (115).

Claim 1 also comprises "sending the network file to the requesting device in response to the request." The network file includes an instruction to transmit an indicator subsequent to the requesting device receiving the network file. The Office action notes that paragraph [0022] of Evans et al. uses the term "trigger." It is asserted in the Office action that Evans et al. teaches a data set with an attached program which triggers a subscription message, citing paragraphs [0022]-[0028]. Applicants assert that nothing

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within these paragraphs would cause a person of ordinary skill in the relevant art to interpret Evans et al. to teach a data set with an attached program which triggers the transmission of a subscription message.

The "triggering" of the subscription message as taught by Evans et al. is based upon the decision to cache a particular data set. Nothing within the data set is identified as being an instruction that triggers the subscription message. Paragraph [0022] refers to actions taken by the proxy server. If the data set selector (130) of the proxy server (100) chooses to store a requested data set in the cache (125), the proxy server may intercept a response from the specified data server (115) to the requesting client device. "On selecting the data set for storage in the cache (125), the data set selector (130) is arranged to trigger the subscription message generator (135) to generate a subscription request message . . ." In Applicants' claim 1, the cause-and-effect relationship is one in which the instruction within the "data set" triggers the transmission of the indicator. This cause-and-effect relationship is not taught by Evans et al. Rather, the decision to store a data set in cache is made before the data set is received by the proxy server or by the requesting client device. This decision which is made before receiving the data file triggers the subscription message generator to generate the subscription message. Paragraph [0022] of Evans et al. does not teach any of the different steps described in pending claim 1.

In paragraph [0023] of Evans et al., actions occur at the data distribution system (110) that registers the subscription request message. The paragraph does not teach or suggest any of the steps described in claim 1. Then, paragraph [0024] describes how updates are "published" when changes to the data set are detected. A copy of each file in which a change is detected is sent to a predetermined destination. Clearly, this does not teach or suggest the steps described in claim 1.

Paragraph [0025] states that when the proxy server receives an updated copy, the previously stored copy is overwritten. The next paragraph states that updating to the files stored on the originating data servers may be made available by third party sources. Paragraphs [0027] and [0028] refer to possible alternatives in implementation of the Evans et al. invention. None of these paragraphs teaches or suggests a network file that includes an instruction to transmit an indicator subsequent to a requesting device receiving a network file, where the indicator is processed to track hits for the network file.

The Office action agrees that Evans et al. does not explicitly detail processing the indicator to track the hits for the network file. Therefore,

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McBrearty et al. was cited. McBrearty et al. does not teach transmitting an indicator from a requesting device and processing the indicator to track hits for the network file. Rather, the indicator identified in the Office action as being taught by McBrearty et al. is a transmission to the requesting device, not an indicator transmitted from the requesting device. The Office action cites the ABSTRACT and paragraph [0006] of McBrearty et al. as being relevant. As stated in the first paragraph of the ABSTRACT, activity rate information of a web site providing a web document at the particular time of day of the proposed request is presented to a user requesting a web document at a requesting web station, so that the user may choose to request the web document at a different time if there is an indication of high activity at the web site which may cause a delay. Thus, one fundamental difference between the teachings of McBrearty et al. and the invention described in claim 1 is that the indicator of claim 1 is processed to track hits, while the "indicator" of McBrearty et al. is one that identifies the results of the tracking of hits. Another fundamental difference is that the indicator of claim 1 is transmitted from the requesting device, while the indicator of McBrearty et al. is received at the requesting device. Even if one were to modify Evans et al. in view of McBrearty et al., the resulting method would not render claim 1 obvious under Section 103(a). Moreover, Applicants request additional information as to how the teachings of McBrearty et al. could be incorporated into the invention described in Evans et al.

It is respectfully submitted that claim 1 and its dependent claims are patentably distinguishable over the teachings of the cited prior art.

2. Patentability of Claims 12-16

Claim 12 describes a method of counting the number of accesses for cacheable documents. The method includes embedding executable code in each of a plurality of cacheable documents, with the executable code including an instruction triggering transmissions of count-inducing messages from client devices.

Evans et al. is cited for allegedly teaching a data set with an attached program that triggers a subscription messages. Applicants respectfully assert that this is a misinterpretation of the teachings of Evans et al. Paragraph [0022] of Evans et al. states that the triggering of the subscription method is based on selecting a file for storage in cache. The decision is not based upon embedded executable code. Rather, paragraph [0021] of Evans

et al. states that the decision may be based upon a "conventional selection algorithm," as described in paragraph [0003]. The example provided in paragraph [0003] of Evans et al. is one in which the file is selected for caching if access to the file is requested from three or more different users over a predetermined time period.

Claim 12 also includes "receiving said count-inducing messages transmitted from said client devices as responses to execution of said executable code upon reception of said cacheable documents." The ABSTRACT of McBrearty et al. is cited for this teaching. However, the ABSTRACT refers to an "indicator" being transmitted to the client devices, rather than an indicator being received from the client devices. Thus, the combination of the two prior art references does not render claim 12 obvious. Moreover, the indicator of the ABSTRACT of McBrearty et al. is one that is received prior to the reception of the cacheable documents at the client devices, since the indicator of McBrearty et al. allows a person at the client device to determine whether to request the cacheable documents. Thus, McBrearty et al. teaches away from Applicants' claimed invention. Then, claim 12 states that the method includes counting the accesses on a basis of receiving a count-inducing message. This is inconsistent with the teachings of McBrearty et al., since the "indicator" of the prior art reference is the count itself and not the mechanism that permits the count to occur. That is, the indicator of McBrearty et al. is a result, rather than the means to the result.

Reconsideration of claims 12-16 is respectfully requested.

3. Patentability of Claims 17-20

The rejection of system claims 17-20 is consistent with the rejection of the method claims as set forth above. Therefore, many of the remarks made above with regard to the patentability of the method claims apply in the determination of the patentability of the system claims.

In the system of claim 17, each of the network files has a command to initiate a transmission of an identifier from any of a plurality of client devices upon receipt of one of the network files by the client devices. The Office action states that Evans et al. teaches a data set with an attached program which triggers the subscription message. However, Evans et al. teaches that a decision triggers the subscription message, not the reception of the data set. Moreover, the subscription message of Evans et al. is transmitted from the proxy server and not the client devices.

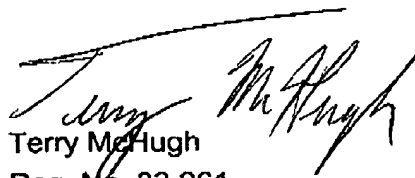
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In McBrearty et al., the indicator is received at the client devices. The indicator identifies results of a count. Thus, the indicator of McBrearty et al. does not teach the claim 17 component of a file access counter responsive to receiving said identifiers as a basis for counting transfers. The combination of Evans et al. and McBrearty et al. does not present a *prima facie* case of obviousness under Section 103(a).

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,



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